

REMARKS/ARGUMENTS

In the office action dated October 17, 2007, claims 1-26 were rejected. Upon entry of this amendment, claims 1 and 17 have been amended, claims 4, 5, 25 and 26 have been canceled. Claims 1-3 and 6-24 are pending in the above-captioned case, all of which stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,902,225 (“Monson”) in view of EP 170 269 (“EP”). Claims 25-26 are rejected under 35 U.S.C. §112, paragraph two as being indefinite. Applicants respectfully submit that no new matter has been introduced by way of the above-noted amendment.

Applicants traverse and respectfully request reconsideration and withdrawal of the rejection of claims 1-3 and 6-24 as being obvious over Monson in view of EP.

According to the Office action, Monson teaches a post-foamable skin and hair composition comprising a concentrate and a diluent “which the former reads on the instant intermediate.” The Office action also states that Monson “suggests several polymers for adjusting the viscosity of the composition.” The Office action admits that Monson fails to teach the claimed lactic acid and specific moisturizers. To remedy this and other deficiencies in Monson, the Office action sites EP for its teaching of skin or hair compositions that include “surfactants, vitamin E acetate, lactic acid, lactate, etc.” The Office action contends that “both Monson and EP are directed to foamable compositions and accordingly it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.”

Applicants take the position that there is no *prima facie* case of obviousness for the pending claims over Monson in view of EP. The Office action urges that it would have been obvious to include specific polymers in a specific range for adjusting the viscosity of the composition. However, this argument breaks down in light of the fact that neither Monson or EP disclose or suggest a composition that includes an intermediate that comprises a polymer blend that includes at least one carbomer, at least one hydroxypropylmethylcellulose, and at least one hydroxyethylcellulose as recited in claims 1 and 17. “To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art.” *M.P.E.P* § 2143.03. In contrast, Monson generally discloses a post-foaming gel

that includes a foamable utilitarian constituent, a liquid post-foaming agent, and a compressed gas. Although Monson optionally includes an amount of Carbopol ETD (a carbomer) between 1.5% and 1.75% by weight, this range is different from the range currently recited in amended claim 1 (about 0.8% to about 1.1%) and is only one part of the polymer blend recited in claims 1 and 17.

Further, Monson's generic disclosure with respect to suspending agents and thickening agents is so broad as to encompass a very large number of possible distinct compositions. As a result, this situation is analogous to obviousness of a species when the prior art broadly discloses a genus. *See M.P.E.P § 2144.08*. In such a situation, the Office is advised to "find additional prior art to show that the differences between the prior art primary reference and the claimed invention as a whole would have been obvious." *Id. See also In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."). Additionally, when prior art discloses a genus, the Office should make findings of: "(A) the structure of the disclosed prior art genus and that of any expressly described species or subgenus within the genus; (B) any physical or chemical properties and utilities disclosed for the genus, as well as any suggested limitations on the usefulness of the genus, and any problems alleged to be addressed by the genus; (C) the predictability of the technology; and (D) the number of species encompassed by the genus taking into consideration all of the variables possible." *M.P.E.P § 2144.08*. Because the Office has not set forth any specific findings regarding the "suspending or thickening agents" mentioned in Monson, it follows that the Office has not set forth a *prima facie* case of obviousness and the obviousness rejection should be withdrawn.

Moreover, the Office action states that because "Monson suggests several polymers for adjusting the viscosity of the composition" that "in the absence of any unexpected advantage, one of an ordinary skill in the art would have employed one or more polymers for adjusting the viscosity of the composition." *Office Action* pg. 4-5. However, it has been found that the presently claimed composition is a notable improvement over the cited art as seen in the studies presented in Figures 1-16 of the current specification. Here, applicants' showing of unexpected results is sufficient to overcome the obviousness rejection.

The difference between Monson's results and applicants' results clearly show an unexpected advantage of the presently claimed composition. Showing unexpected results is most often applied "to the less predictable fields, such as chemistry, where minor changes in a product or process may yield substantially different results." *In re Mayne*, 104 F.3d 1339, 1343 (Fed. Cir. 1997) quoting *In re Soni*, 54 F.3d 746, 750 (Fed. Cir. 1995). Monson discloses using thickening and suspending agents in the composition. However, applicants' use of a polymer blend clearly shows results that are different and thus, unexpected from that disclosed in Monson. Monson admits that the second stage foam composition has an "increased volume and thick, airy, lacy character." (Col. 11, Lines 32-33). In contrast, it is evident from the comparative test data in the instant application that applicants' composition yields completely different results in terms of bubble size as compared to Monson. Applicants bubbles are tighter, smaller, and more numerous (as shown in the figures), which is different and unexpected from this of the "lacy" character of the Monson bubbles. As stated in the specification, bubble size greatly impacts shaving:

In a skin preparation composition, especially in one used as a preparation for shaving, the size and numbers of bubbles produced are important factors for use as a lubricant and humectant. The smaller the bubbles, the more surface area is present to hold water to the skin of a user and thus easier it is [to] shave. ... [E]ven at the lesser pressure of 40 psig the current formulation results in a smaller bubble size throughout the time span.

Applicants' specification at 6.

Still further, applicants' position is underscored by Monson's discussion about problems of the prior art. Namely, that "foam and foam stability are associated with cleaning ability" and "foams provide a particularly pleasing effect or feel if a rich, slightly wet, creamy foam can be achieved." Monson proposes to remedy these defects of the prior art by providing a composition having a bubble texture that is "airy and lacy." (Col. 11, Lines 32-33) However, when discussing the addition of thickening agents to the Monson composition, Monson states that "the composition of the present invention may also contain minor amounts of conventional additional ingredients to impart various desired characteristics to the composition," including thickening agents. (Col. 7, Lines 24-27). Therefore, a person having ordinary skill in the art would not be motivated or directed to add thickening agents or suspending agents to the composition in the amounts specified in the pending claims other than by adding Carbopol in an amount of between

1.5% and 1.75% by weight, which does not teach or suggest “a polymer blend that comprises at least one carbomer, at least one hydroxypropylmethylcellulose, and at least one hydroxyethycellulose,” as recited in claims 1 and 17 or the above-noted polymer blend in an amount of “about .08% to about 1.1% by weight of the intermediate constituent “ as recited in claim 1. The difference between applicants’ foam and Monson’s foam are not merely optimizations of Monson’s technology as argued in the Office action. Instead, applicants identified a composition and a shaving cream that differ from Monson’s teachings by involving a polymer blend that results in surprisingly different effects, namely the greater number of smaller sized bubbles.

The EP reference fails to cure Monson’s shortcomings as a Section 103 reference in this context. The EP reference also does not disclose or suggest using a polymer blend as recited in amended claims 1 and 17. As such, the EP reference cannot cure Monson’s deficiencies.

Because none of the cited art, alone or in combination, discloses or suggests all of the claim limitations of the claims at issue, it follows that such claims are not obvious thereover.

Further, because independent claims 1 and 17 are not disclosed or suggested by the cited art, it follows that any claim dependent on independent claims 1 and 17 are not disclosed or suggested by the cited art. Accordingly, each of dependent claims 2 and 3, 6-16, and 17-24 is allowable for at least the same reasons discussed in regard to independent claims 1 and 17. As a result, reconsideration and allowance of the foregoing claims, as amended, are respectfully requested.

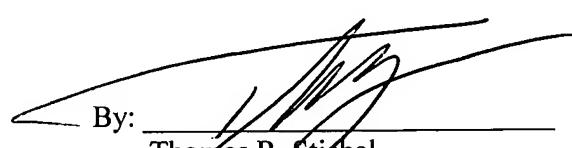
Appl. No. 10/643,500
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Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees, which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

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